Rej ctions Based on D ubl Patenting

In the Office Action mailed October 4, 2000, the Examiner rejected claims 1-5, 7-12, 14-19, 21-26, and 28-29 under the doctrine of obviousness-type double patenting, in light of claims 1-22 of U.S. Patent No. 5,871,449. The applicant is in the process of recording a patent assignment with the United States Patent and Trademark Office. Upon completion of the recordation process, the assignee will execute a terminal disclaimer which will disclaim the terminal part of any patent granted on the above-captioned application, which would extend beyond the expiration date of the full statutory period of U.S. Patent No. 5,871,449. The filing of the terminal disclaimer will thereby obviate the double patenting rejection.

Rejections under 35 USC §112

Claims 1 and 23 have been rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicants regard as the invention. By the above amendment it is respectfully submitted that all claims present in the application are in full compliance with 35 USC §112, second paragraph. Applicants note that such amendments are not intended to limit the scope of the claimed invention. Rather, such amendments are being made solely in response to Examiner's rejection under 35 USC §112.

Rejections under 35 USC §102

"Anticipation is established only when a single prior art reference discloses expressly or under the principles of inherency, each and every element of the claimed invention." RCA Corp. v. Applied Digital Data Systems, Inc., (1984, CA FC) 221 U.S.P.Q. 385. The standard for lack of novelty, that is, for "anticipation," is one of strict identity. To anticipate a claim, a patent or a single prior art reference must contain all of the essential elements of the particular claims. Schroeder v. Owens-Corning Fiberglass Corp., 514 F.2d 901, 185 U.S.P.Q. 723 (9th Cir. 1975); and Cool-Fin Elecs. Corp. v. International Elec. Research Corp., 491 F.2d 660, 180 U.S.P.Q. 481 (9th Cir. 1974). "A rejection for anticipation under §102 requires that **each and every** limitation of the claimed invention be disclosed in a single prior art reference." In re Paulsen, 31 U.S.P.Q.2d 1671, 1673 (Fed. Cir. 1994)(emphasis added).

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In the present case, the Examiner rejected claims 1, 3-5, 7-9, 11-12, 14-16, 18, 20-23, 25-26, and 28-29 as being anticipated by Casscells et al. (5,935,075).

The present invention discloses a system for locating inflamed plaque in a vessel and a method of using the disclosed system. More specifically, claims 1 and 9 recite a system comprising a receiver capable of receiving information regarding the vessel, a positioner capable of positioning the receiver within the vessel under examination, and a sensor capable of receiving and processing receiver information. The device further includes a flow passageway enabling the positioning of the device within a vessel and capable of allowing fluid to flow past the device without occluding the vessel. Methods of locating plaque located on vessel walls are disclosed in claims 16 and 23. More specifically, claims 16 and 23 disclose methods of practicing the present invention which include the step of allowing fluid to flow past the receiver without occluding the vessel.

Casscells et al. discloses a catheter device and method for detecting thermal discrepancies in vessels walls. More particularly, the catheter apparatus 10 utilizes an inflatable balloon 40, a signal fiber 50, and a reference fiber 60 to detect the thermal characteristic of a situs. Casscells et al. states "Depending on the natural direction of blood flow within the artery, inflation of balloon 40 would substantially limit flow of blood ..." (Col. 13, l. 37-39). Therefore, Casscells et al. teaches an apparatus and method that occludes the vessel and restricts blood flow through the vessel. In contrast, the present invention includes flow through the device so as not to occlude the vessel. Thus, Casscells et al. teaches away from the present invention.

The Casscells et al. patent neither teaches nor suggests the invention of claims 1, 9, 16, and 23 of the present invention. Thus, applicant respectfully submits that these claims, and all claims dependent therefrom, are allowable over the Casscells et al. patent.

Rejections under 35 USC §103

In the present case, Examiner Casler rejected claims 6, 13, 20, and 27 under 35 USC §103(a) as being obvious under Casscells et al. (5,935,075) in view of Narciso et al. (5,217,456). Applicant respectfully traverses this rejection.

As stated above, independent claims 1, 9 16, and 23 are patentable over Casscells et al. in that they all claim an invention wherein fluid flow through the positioner is allowed so that the vessel is not occluded. Thus, dependent claims 6, 13, 20, and 27 are also patentable over Casscells et al. Furthermore, Narcisco et al. does not teach of suggest fluid flow through a postioner. Thus, all of the pending claims are patentable over Narcisco et al. Since neither Casscells et al. nor Narcisco et al. teach fluid flow through a positioner, all of the claims of the present invention are patentable over Casscells et al. and Narcisco et al., either alone or in combination.

In view of the above remarks, it is submitted that all of the pending claims are in condition for allowance and allowance of claims 1–29 is earnestly solicited.

CONCLUSION

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned **"Version with Markings To Show Changes Made."**

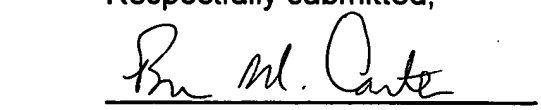
For the foregoing reasons, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested.

If it is felt for any reason that direct communication with applicants' attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned attorney at the below listed telephone number.

The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to deposit account No. 16-2230.

Respectfully submitted,

Dated: June 27, 2001



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V rsion with Markings to Show Changes

In The Claims

Please amend claims 1, 9, 16, and 23 as follows:

1. (Amended) A device for locating inflamed plaque on [a vessel] the wall of a vessel of a patient, the device comprising:

at least one receiver insertable into the vessel, the receiver being adapted to receive information from the patient;

a positioner [for] capable of selectively positioning the at least one receiver in the vessel, the positioner including a flow passageway capable of allowing fluid to flow past the postioner; and

a sensor [for] capable of receiving information from the receiver and determining [the presence of] whether inflamed plaque is present based upon the information received from the receiver.

9. (Amended) A device for measuring temperature in a vessel wall of a vessel of a patient, the device comprising:

at least one receiver, insertable into the vessel, for receiving information about the vessel wall;

a positioner [for] capable of selectively positioning the at least one receiver proximate the vessel wall, the positioner including a flow passageway capable of allowing fluid to flow past the postioner; and

a sensor [for] capable of receiving the information from the at least one receiver and determining the temperature at the at least one receiver based upon the information received.

16. (Amended) A method for determining a temperature at a vessel wall of an vessel, the method comprising the steps of:

providing a receiver insertable into the vessel, the receiver being adapted to receive information regarding the vessel wall;

advancing the receiver in the vessel;

allowing fluid to flow past the receiver without occluding the vessel;

transferring the information from the receiver to a sensor; and

determining the temperature of the vessel at the receiver with the sensor.

23. (Amended) A method of locating inflamed plaque on a vessel wall of a vessel of a patient, the method comprising the steps of:

providing a receiver, the receiver being adapted to receive information about the patient;

selectively positioning the receiver in the vessel;

allowing fluid to flow past the receiver without occluding the vessel; and

determining [the presence of] whether inflamed plaque is present based upon the information received from the receiver.